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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK W. HUBBARD, JOSEPH B. RAINSBERGER,
RAMIAH KWOK-FAI TIN, and TACK TONG

Appeal 2007-4394
Application 09/998,111
Technology Center 3600

Decided: [Date of mailing]

Before LINDA E. HORNER, DAVID B. WALKER, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-55, all the claims currently pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants' claimed invention is directed to a system and method for presenting marketing content on a web page (Spec. 4:13-15). Claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A system for presenting marketing content on a web page, the system comprising:
>
> (a) a web page;
>
> (b) a marketing page element placed anywhere on the web page, said marketing page element providing storage for data items having marketing content for a marketed item, wherein the data items are for displaying on the web page; and
>
> (c) a marketing content selection system connected to said marketing page element, wherein said marketing content selection system is adapted to select said data items to be stored in said marketing page element using a marketing strategy for selecting the marketed item.

THE REJECTIONS

The Examiner relies upon the following evidence in the rejections:

Gerace	US 5,848,396	Dec. 8, 1998
Culliss	US 6,078,916	Jun. 20, 2000
Petty	US 6,342,907 B1	Jan. 29, 2002

The following rejections are before us for review.

1.Claims 1-9, 11-21, 23-33, 35-47, and 49-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerace and Culliss.

2.Claims 10, 22, 34, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerace, Culliss, and Petty.

ISSUES

Appellants contend that the combination of Gerace and Culliss fails to teach or suggest (1) "a marketing page element as included in the present invention"(Br. 9), (2) "an element of the web page for storing marketing content for a marketed item for displaying on the web page" (Br. 6), and (3) "that the objects into which the data is stored are elements of a web site or that the data to be displayed on a web site is stored in a element of the web site" (Br. 7). The Examiner found that Gerace teaches a marketing page element as claimed inasmuch as Gerace teaches using page display objects to define the screen views, i.e., web pages, transmitted and displayed to end users, the page display objects holding agate or other data to be displayed including advertisements which are themselves objects (Answer 21).

The issues before us are:

1.Whether Appellants have shown that the Examiner erred in rejecting claims 1-9, 11-21, 23-33, 35-47, and 49-55 as being unpatentable over Gerace and Culliss.

2.Whether Appellants have shown that the Examiner erred in rejecting claims 10, 22, 34, and 48 as being unpatentable over Gerace, Culliss, and Petty.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed.

Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1.Appellants' Specification defines the term "marketing page element" as a collection of one or more marketing page element items, where the page element item is an object representing a specific instance of a marketing content element (Spec. 6:9-13).

2.Gerace teaches page display objects that define the screen views, i.e., web-pages, transmitted and displayed to end users (Gerace, col. 7, ll. 23-25).

3.Page data objects 35b hold the agate or other data to be displayed to end users, including advertisements which are objects themselves (Gerace, col. 7, ll. 28-31). Therefore, the page data objects of Gerace are objects comprising marketing content objects which are displayed to a user.

4.Page data objects 35b support page display objects 35c which outline the possible screen content and presentation formats in which agate data advertisements are to be displayed (Gerace, col. 7, ll. 32-37).

5.Advertisements are positioned along the periphery (i.e., above, below, left or right) of the agate data, as defined by a respective page display object 35c (Gerace, col. 7, ll. 32-34).

6.Advertisements are selected by main routine 39 by determining, for each Ad Package Object 33b, if the advertisements there are appropriate for the user, and ranking all appropriate advertisements (Gerace, col. 14, l. 66 to col. 15, l. 4).

7.To determine the appropriateness, for each ad placed by a sponsor, the sponsor weights demographic and psychographic criteria by importance and

identifies which terms are required (Gerace, col. 15, ll. 4-10). Therefore, Gerace teaches that the marketing strategy for selecting the data items to be displayed to a user is based in part on an if-then (action) format.

8.Appellants' Specification states that it is known in the art to utilize Java and Java Server Pages to design web pages (Spec. 2:13-18).

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 17-18.

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR,* 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."

ANALYSIS

Rejection of claims 1-9, 11-21, 23-33, 35-47, and 49-55 as unpatentable over Gerace and Culliss

Appellants argue claims 1-3, 5-9, 11-15, 17-21, 23-27, 29-33, 35-41, 43-47, and 49-55 as a group (Br. 5-9). We select claim 1 as a representative claim and the remaining claims of the group stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

In order to determine the patentability of claim 1 over the cited prior art, the claim must be interpreted to ascertain its proper scope and/or meaning. In interpreting claim language, we apply the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). *See also In re Am. Acad. of Sci. Tech. Ctr.*,

367 F.3d 1359, 1364 (Fed. Cir. 2004) and *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). It is Appellant's burden to precisely define the invention. *See In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Claim 1 defines a system for presenting marketing content on a web page. The system includes, *inter alia*, a marketing page element, said marketing page element providing storage for data items having marketing content for a marketed item. Appellants' Specification defines a marketing page element as a collection of one or more marketing page element items, where the page element item is an object representing a specific instance of a marketing content element (Finding of Fact 1). Accordingly, the broadest reasonable interpretation of a "marketing page element" is one or more objects which comprise marketing content objects which are displayed to a user.

Appellants contend that Gerace fails to disclose an element that "is both placed on a web page and provides storage for data items having marketing content for a marketed item for displaying on the web page" (Br. 6). The Examiner found that Gerace teaches a marketing page element as claimed inasmuch as Gerace teaches using page display objects and page data objects to define the screen views, i.e., web pages, transmitted and displayed to end users, the page data objects holding agate or other data to be displayed including advertisements which are themselves objects (Answer 21). Appellants have not provided any evidence or argument that the page data objects of Gerace are not marketing page elements as claimed. Appellants merely assert that although Gerace teaches "storage and/or display of data which may include advertising," it "does not teach or suggest that

the objects into which the data is stored are elements of a web site or that the data to be displayed on a web site is stored in a[n] element of the web site" (Br. 7). We disagree.

Gerace teaches that page display objects 35a-35c define the screen views, i.e., web pages, transmitted and displayed to end users (Finding of Fact 2). In addition, Gerace teaches that page data objects 35b hold the agate or other data to be displayed to end users, including advertisements which are themselves objects (Finding of Fact 3). Therefore, the page data objects 35b of Gerace are objects comprising marketing content objects which are displayed to a user. Furthermore, these objects are elements of a web page inasmuch as they define the web page which is displayed to the user.

Appellants further contend that Gerace "does not teach or suggest that the data items [stored in the marketing page element] correspond to a marketed item" (Br. 9). More specifically, Appellants contend that the marketing content of Gerace "is limited to advertising banners," not a product or coupon as in the claimed invention (*Id.*). Appellants' argument is not commensurate with the scope of the claimed invention. Claim 1 recites, *inter alia*, providing storage for data items having marketing content for a marketed item. Therefore, the claimed invention does not require the data items to be the marketed product as suggested by Appellants. To the contrary, the data items need only contain marketing content, for example, an advertising banner as taught in Gerace, for a marketed item.

For at least those reasons presented above, we find that Appellants have not shown that the Examiner erred in rejecting claims 1-3, 5-9, 11-15, 17-21, 23-27, 29-33, 35-41, 43-47, and 49-55 as unpatentable over Gerace and Culliss.

Appellants argue claims 4, 16, 28, and 42 as a group (Br. 9-10). As such, we select claim 4 as a representative claim and the remaining claims of the group stand or fall with claim 4. 37 C.F.R. § 41.37(c)(1)(vii) (2007). Claim 4 recites that the marketing strategy "is specified by a business rule in an if – then (action) format."

Appellants contend that Gerace fails to disclose or suggest that the format of the marketing strategy is in an if-then (action) format (Br. 10). The Examiner found that the targeted marketing features of Gerace, including targeting both advertising content and advertising format to certain target users, constituted a marketing strategy based on business rules in the format of if-then (action) (Answer 9). More specifically, the Examiner found that an exemplary business rule according to the teachings of Gerace would be "if a target age group can be identified that responds to certain advertisements more favorably, then market that age group with that type of advertisement" (*Id.)*.

Furthermore, Gerace teaches that advertisements are selected by main routine 39 by determining, for each Ad Package Object 33b, if the advertisements there are appropriate for the user, and ranking all appropriate advertisements (Finding of Fact 6*)*. To determine the appropriateness, for each ad placed by a sponsor, the sponsor weights demographic and psychographic criteria by importance and identifies which terms are required (Finding of Fact 7). Therefore,

Gerace teaches that the marketing strategy for selecting the data items to be displayed to a user is based in part on an if-then (action) format (Finding of Fact 7). As such, we sustain the Examiner's rejection of claims 4, 16, 28, and 42 as unpatentable over Gerace and Culliss.

Rejection of claims 10, 22, 34, and 48 as unpatentable over Gerace, Culliss, and Petty

Appellants argue claims 10, 22, 34, and 48 as a group (Br. 10-11). As such, we select claim 10 as a representative claim and the remaining claims of the group stand or fall with claim 10. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Appellants contend that Petty fails to teach or suggest "a web page that is a Java Server Page" or that "its Java beans include an element of a web page, such as the marketing page element of the claimed invention" (Br. 10). The Examiner found that although Gerace does not explicitly teach utilizing Data Beans or a Java Server Page to implement the page data objects or the advertising objects, Petty teaches using Java Server Pages and Data Beans (Answer 13). Therefore, the Examiner held it would have been obvious to one of ordinary skill in the art to utilize Java Server Pages and Data Beans to implement Gerace's web pages in order to provide greater architecture flexibility and platform independence (*Id.*).

Where, as here "[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result," *KSR*, 127 S.Ct. at 1740 (citing *United States v. Adams*, 383 U.S. 50-51 (1966)). Appellants have provided no evidence that utilizing Data Beans and a Java Server

Page to implement the data display objects and web pages of Gerace yields an unexpected result or was uniquely challenging or difficult for one of ordinary skill in the art. To the contrary, Appellants' Specification states that it is known in the art to utilize Java and Java Server Pages to design web pages (Finding of Fact 8). As such, we sustain the Examiner's rejection of claims 10, 22, 34, and 48 as unpatentable over Gerace, Culliss, and Petty.

CONCLUSIONS OF LAW

We conclude Appellants have not shown that the Examiner erred in rejecting claims 1-9, 11-21, 23-33, 35-47, and 49-55 as unpatentable over Gerace and Culliss, and claims 10, 22, 34, and 48 as unpatentable over Gerace, Culliss, and Petty.

DECISION

The Examiner's decision under 35 U.S.C. § 103(a) to reject claims 1-55 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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